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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,856	01/11/2002	Jean-Luc Pous	22.1489	8450

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EXAMINER	
ROSEN, NICHOLAS D	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/043,856	POUS ET AL.	
	Examiner	Art Unit	
	Nicholas D. Rosen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *38 and 42-62* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *38 and 42-62* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 38 and 42-62 have been examined.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 26, 2006 (certified as mailed May 22, 2006) has been entered.

Claim Objections

Claims 56-62 are objected to because of the following informalities: In the sixth line of claim 56, "selection of selections" should be "selections", and "to used as" should be "to be used as"; even more seriously, "compile selections" is written as a method step, but claim 56 is a system claim. Appropriate correction is required.

Claims 57-62 are objected to because of the following informalities: Each of claims 57 and 60 through 62 depend on "The method of claim 56"; claims 58 and 59 depend on "The method of claim 57"; all of claims 57-62 recite limitations in the form of method steps. However, claim 56 is a system claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 42-55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 42 recites an online catalog having a selector "to select an unavailable product or attribute that is not offered for sale." This is not supported by the specification, which only describes selecting an unavailable product which is not immediately available, but is offered for sale, receipt of the presently unavailable product to take place after some degree of engineering or development, and after the product is made. Note especially pages 6 and 7.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 38

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) in view of official notice. House discloses a method for offering products, comprising: providing a set of available product records, each available product record containing a specification for an associated product (column 9,

lines 30-36); and providing a set of variance data records, each variance data record containing an allowed variance to an associated product (column 8, line 64, through column 9, line 13; column 9, lines 30-36); displaying product data records on a visual display (column 13, line 22, through column 14, line 16), where at least some of the product records are for custom-engineered products, therefore variable records, while some of the basics products may well be available, official notice being taken that it is well known to have products already assembled and available; and House discloses receiving an input, via a user interface selection device, of a user selection from the set of unavailable product data records (Abstract; column 9, lines 30-36; column 13, line 22, through column 14, line 16).

Claims 42-55

Claims 42, 44, 45, 53, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) in view of the anonymous article, "EMCORE Announces Expectations for Record Year End Revenue and Substantial Increases in 2001 Backlog," hereinafter "EMCORE." As per claim 42, House discloses a method for providing custom-engineered products, the method comprising: providing an online catalog having an unavailable product/attribute selector to select an unavailable product or attribute that is not offered for sale, in the sense of not currently existing for sale (Abstract; column 2, line 48, through column 3, line 9; column 3, line 49, through column 4, line 4; column 4, line 41, through column 5, line 3; column 8, line 64, through column 9, line 36; column 10, lines 55-60; column 16, lines 14-27; column 29, lines 13-17). House does not disclose using selections of

unavailable products or attributes that are not offered for sale as market research to determine whether to extend a product offering that includes the unavailable products or attributes, but it is well known to use selections of unavailable products or attributes as market research to determine whether to extend a product offering that includes the unavailable products or attributes, as taught by "EMCORE" (two paragraphs beginning from "EMCORE will accelerate"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use the selections as market research to determine whether to extend a product offering, for the obvious advantage of profiting from offering a product for which there is demonstrated customer demand.

As per claim 44, House discloses determining a resource cost for the unavailable product/attribute (column 4, lines 15-23).

As per claim 45, House discloses assigning a category of design requirements to the unavailable product/attribute (column 9, lines 30-36; column 12, lines 17-29).

As per claim 53, House discloses that the unavailable product/attribute selector comprises a list of unavailable products/attributes (column 9, lines 30-36; column 13, lines 38-48).

As per claim 54, the existence and availability of at least one such list (as in claim 53, above) inherently requires at least one item to have been classified in the list.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) and "EMCORE" as applied to claim 42 above and further in view of Joseph (U.S. Patent 5,878,401). House does not disclose suggesting an

existing/standard product based upon and as a replacement for the selection, but Joseph teaches suggesting an existing/standard product based upon and as a replacement for the selection of an unavailable item (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do this, for the obvious advantages of profiting from the sale of a recommended item, and saving the time needed to custom-manufacture an unavailable product.

Claims 46, 47, 48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) and "EMCORE" as applied to claim 45 above and further in view of official notice. As per claim 46, House discloses determining a resource cost for the unavailable product/attribute (column 4, lines 15-23). House does not disclose assigning a first category to the unavailable product attribute if the resource cost is relatively lower; and assigning a second category to the unavailable product attribute if the resource cost is relatively higher, but it is well known to assign categories to items based on cost. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to assign respective first and second categories based on lower or higher cost, for such obvious advantages as assigning priority to engineer and manufacture a product, or track the results of a business practice, for possible modification.

As per claims 47 and 48, House discloses transmitting a request to a manufacturing facility for the product/attribute if is assigned to a first category (whatever that category may be) (column 7, lines 44-46), and official notice is taken that it is well

known for transmissions to be transmissions to an appropriate address. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit a request for the unavailable product/attribute to an address with the assigned category, for the obvious advantage of causing appropriate action to be taken regarding the product/attribute; and to transmit the request to a manufacturing facility, for the obvious advantage of causing the product to be manufactured.

As per claim 49, House not expressly disclose the request to an engineering department for the unavailable product/attribute, but does disclose that an unavailable product/attribute may require engineering services, and that orders are sent to the appropriate personnel or department for engineering services (column 4, lines 12-27; column 4, line 59, through column 5, line 3; column 11, lines 6-21), and discloses transmitting information to a relevant department (column 7, lines 44-46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit the request to an engineering department if it is assigned to a second predefined category, for the obvious advantage of making the information readily available to the engineering department to perform the necessary engineering.

Claims 50, 52, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) and "EMCORE" as applied to claim 42 above and further in view of official notice. As per claim 50, House does not expressly disclose providing a list of available products in the online catalog, but official

notice is taken that it is well known to provide lists of available products in online catalogs. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do this, for the obvious advantage of profiting from the sale of products already available and in stock.

As per claim 52, House discloses transmitting a request to a manufacturing facility (column 7, lines 44-46). Whether this is for receiving an order for an available product depends on the meaning of "available," in that House's products are ordinarily not already sitting in inventory, but are in some cases available to be manufactured from available parts without significant testing or engineering (column 2, lines 35-44; column 4, lines 28-40), and are therefore available by Applicant's definition (the instant application, page 3, lines 1-4; page 6, line 6, through page 8, line 2); moreover, if "available" meant "already sitting on a shelf," transmitting a request to a manufacturing facility would be less necessary. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention of providing available products to would-be purchasers.

As per claim 55, House does not expressly disclose that the unavailable product/attribute selector comprises an online form (although House's disclosure regarding lists, menus, etc. could be read as implying an online form), but official notice is taken that it is well known to make catalog selections, etc., from an online form. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the unavailable product/attribute selector to comprise an online form, for the obvious advantage of enabling users to

make selections in a standard manner likely to be familiar to users and to interface designers.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805), "EMCORE," and official notice as applied to claim 50 above and further in view of Hunter et al. (U.S. Patent 6,850,901). House does not disclose obsoleting an available product by moving it from the list of available products to a list of unavailable products, but Hunter teaches updating the status of products from available to unavailable (column 9, lines 25-41), which may be in an online catalog (column 6, lines 5-12). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to obsolete an available product by moving it from the list of available products to a list of unavailable products, for the obvious advantage of informing shoppers which products are readily available, and which would require delay or custom manufacture, and profiting from resulting sales.

Claims 56-62

Claims 56, 57, 58, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) in view of the anonymous article, "EMCORE Announces Expectations for Record Year End Revenue and Substantial Increases in 2001 Backlog," hereinafter "EMCORE." As per claim 56, House discloses a server which performs processing (column 11, line 56, through column 12, line 5); and a user interface selection device in communication with said processor (Abstract; column 2, line 48, through column 3, line 9; column 3, line 49,

through column 4, line 4; column 9, lines 14-36; column 10, lines 55-60) to select products or attribute which that are not currently offered in a line of available products or attributes from a provider (ibid.; see also column 4, line 41, through column 5, line 3; column 8, line 64, through column 9, line 13; column 16, lines 14-27; column 29, lines 13-17). House does not quite expressly disclose that the user interface selection device is adapted to display a list of products or attributes at are not currently offered in a line of available products or attributes, but House discloses a list of selectable features and/or components (column 9, lines 30-36), making display of such a list obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the obvious advantage of enabling users to conveniently select such products or attributes.

House does not disclose compiling selections of the available products to be used as market research for a decision of whether to extend a product offering to include the list of products or attributes, but it is well known for selections of products to be used as market research to determine whether to extend a product offering to include the products or attributes, as taught by "EMCORE" (two paragraphs beginning from "EMCORE will accelerate"), and being aware of multiple requests, as taught in "EMCORE," implies compiling them. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention compile selections of the available products to be used as market research to determine whether to extend a product offering to include the products or attributes, for the

obvious advantage of profiting from offering products or attributes for which there is demonstrated customer demand.

As per claim 57, House discloses a list of unavailable products/attributes (ibid., and especially: column 9, lines 30-36; column 13, lines 38-48), implying storing the data in a memory.

As per claim 58, House discloses displaying unavailable products/attributes, as set forth in the rejection of claim 56 above, and displaying a list as such is obvious, also as set forth in the rejection of claim 56 above.

As per claim 59, House discloses categories of design requirements associated with the unavailable product/attribute (column 9, lines 30-36; column 12, lines 17-29), implying storing the data in a memory.

Claims 60 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over House and "EMCORE" as applied to claim 56 above, and further in view of official notice. As per claim 60, House discloses receiving a selection of an unavailable product/attribute (column 4, lines 12-27; column 10, lines 55-60); determining a resource cost for the unavailable product/attribute, and displaying a cost to the user (column 4, lines 15-23; column 10, lines 41-67). Official notice is taken that it is well known to display information on visual interfaces of computer systems; given House's disclosure of a computer system, displaying the cost on a visual interface thereof would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the obvious advantage of conveniently making the information available to users.

As per claim 62, House discloses generating a specification for a product in response to receiving a selection from the user interface selection device of an unavailable product/attribute device (column 4, lines 12-27; column 10, lines 55-60; see also the section of the House patent applied in rejecting claim 56 for further documentation of unavailability). Official notice is taken that it is well know for computer systems to have CPU's which receive and process data; given House's disclosure of a computer system, receiving a selection and generating the specification by a CPU would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the obvious advantage of enabling the method to be carried out using standard computer hardware.

Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over House and "EMCORE" as applied to claim 56 above, and further in view of Joseph (U.S. Patent 5,878,401) and official notice. House discloses receiving a selection of an unavailable product/attribute via a selection signal from a user, and therefore from a user interface device (column 4, lines 12-27; column 10, lines 55-60; see also the section of the House patent applied in rejecting claim 56 for further documentation of unavailability). House does not disclose identifying one or more available products from the list of available products that has similar characteristics to those of the selected unavailable product/attribute, but Joseph teaches suggesting and an existing/standard product based upon and as a replacement for the selection of an unavailable item (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do this, for the obvious

advantages of profiting from the sale of a recommended item, and saving the time needed to custom-manufacture an unavailable product.

Official notice is taken that CPU's are well known, and using a CPU is held to be obvious as set forth in the rejection of claim 62 above.

Response to Arguments

Applicant's arguments filed May 26, 2006 have been fully considered but they are not persuasive. Applicant argues that House fails to teach or suggest using selection of unavailable products/attributes for market research, to which Examiner replies that other art supplies this deficiency, as set forth below. Applicant argues that claim 38 is patentable for at least the reasons set forth in the previous replies; Examiner replies that it is not, and reiterates the arguments set forth in previous Office actions.

Examiner notes that prior art was made of record in the previous Office action in response to traversal of official notice relied on to declare some elements obvious. The other common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The anonymous article, "JA Experience," discloses young

businesspersons conducting market research, taking orders, and determining how much they can sell.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's current acting supervisor, Mark Fadok, can be reached at 571-272-6755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER
June 16, 2006